

Serial No.: 10/667,151

RECEIVED
CENTRAL FAX CENTER
FEB 21 2007REMARKS

Claims 1-39 are pending in the application. Restriction is required to the following allegedly distinct inventions:

- I. Claims 1-21 and 38-39, drawn to an injectable formulation comprising:
 - a) a chemical ablation agent in an amount effective to cause tissue necrosis, and
 - b) a biodisintegrable viscosity adjusting agent in an amount effective to render the formulation highly viscous, wherein said injectable formulation is a sterile injectable formulation, classified in class 424, subclass 463;
- II. Claims 22-26 and 36-37, drawn to a method of treatment comprising injecting the injectable formulation of any of claims 1-21 into the tissue of a subject, classified in class 606, subclass 9+;
- III. Claims 27-32, drawn to a prostatic ablation formulation comprising a prostatic ablation agent selected from free- radical generating ablation agents, oxidizing ablation agents and tissue fixing ablation agents, classified in class 606, subclass 4+;
- IV. Claims 33-35, drawn to a system for the chemical ablation of tissue, said system comprising:
 - a) an injectable formulation comprising: I) a chemical ablation agent in an amount effective to cause tissue necrosis, and II) a biodisintegrable viscosity adjusting agent in an amount effective to render the formulation highly viscous; and
 - b) an apparatus for transcutaneously inserting said dosage form into said tissue, classified in class 607, subclass 92.

Applicants elect the Group I claims, Claims 1-21 and 38-39, for initial prosecution on the merits. Claims 22-26, 36-37, and 33-35 are subject to rejoinder in accordance with the provisions of MPEP 821.04, upon allowance of claim 1.

Serial No.: 10/667,151

Pursuant to 35 U.S.C. 121, election of a single disclosed species of chemical ablation agents is also required, selected from a) osmotic-stress generating agent, b) organic ablation agent, c) salt and d) ethanol. Applicants hereby elect Species a) osmotic-stress generating agent, with traverse. This election is made with traverse, because where two or more species are claimed, a requirement for restriction to a single species is proper only where the species are mutually exclusive (i.e., they must not overlap in scope). See MPEP 806.04(f). Here, Species a), embraces salt and certain organic ablation agents, including ethanol. Thus, while election between species c) and d) may be proper or between species b) and c) may be proper, the species election requirement is improper, because so-called "species" a), b) and e) overlap in scope as do species a) and c). Thus, these "species" listed by the examiner are not mutually exclusive. Withdrawal of the species requirement is requested.

The Applicant is further required to elect a single disclosed species of biodegradable viscosity adjusting agents from i) polysaccharide, ii) polypeptide, iii) gelatin, iv) collagen and v) polymer. Applicants hereby elect Species i) polysaccharide for prosecution on the merits with traverse. As above, this rejection is made with traverse because the alleged species overlap in scope and are not mutually exclusive. MPEP 806.04(f). For example, polysaccharides, polypeptides, gelatin and collagen are all polymers. Moreover, gelatin and collagen are proteins (polypeptides). Withdrawal of the species requirement is requested.

The Applicant is further required to elect a single disclosed species of polysaccharide. Applicant hereby elects species i) methylcellulose.

With respect to those embodiments where two or more viscosity adjusting agents are employed, applicant elects the combination of methylcellulose and hydroxypropyl cellulose.

The election of a single species of sub-formulations is also required based on Applicant's election of the Group I claims.

The Applicant is required to elect a single disclosed species between a) non-imaging contrast containing formulations and b) imaging contrast containing formulations. Applicant hereby elects Species b) imaging contrast agent containing formulations with traverse. This rejection is made with traverse because a requisite for a proper request for a species election is that two or more species must be *claimed*, rather than merely disclosed. See 37 CFR 1.146 (emphasis added):

Serial No.: 10/667,151

In the first action on an application containing a generic claim to a generic invention (genus) and *claims to* [rather than disclosure of] more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable....

Here there is no claim directed to Species a) (i.e., there is no claim directed to a formulation in which an imaging contrast agent is expressly excluded from the formulation). Withdrawal of the species requirement is requested.

As an imaging contrast agent containing injectable formulations is elected, the further election of a single specific contrast agent is also required. The Applicants elect Species (iii) ultrasonic imaging contrast agent comprising solid particles.

The additional election of a single species of crosslinking agents between a) ionically crosslinkable polymer, b) non-ionically crosslinkable polymer and c) non-polymer crosslinking agent is also required due to the election of the Group I claims. The Applicant elects Species a) ionically crosslinkable polymer, with traverse. This rejection is made with traverse because a requisite for a proper request for a species election is that two or more species must be *claimed*, rather than merely disclosed. See 37 CFR 1.146 *supra*. Here the only "species" that appears in the claims is group a). (In other words, there are, at present, no claims directed to b) non-ionically crosslinkable polymer and c) non-polymer crosslinking agent.)

Applicant is further required to elect a single species of cross-linkable polymer among the following: a) alginate polymer. Applicant hereby elects species a) alginate polymer with traverse. This rejection is made with traverse because a requisite for a proper request for a species election is that two or more species must be claimed, rather than merely disclosed. See 37 CFR 1.146 *supra*. Here, only a single "species" is disclosed.

Claims 1-10, 14, 16-21, 38 and 39 are readable upon the species elected herein.

Should the Examiner be of the view that an interview would expedite consideration of the application, request is made that the Examiner telephone the Applicants' attorney at (703) 433-0510 in order that any outstanding issues be resolved.

Serial No.: 10/667,151

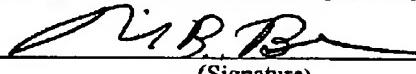
Respectfully submitted,



David B. Bonham
Registration No. 34,297

I hereby certify that this correspondence is being deposited with the United States Patent and Trademark Office on 2/21/07 via facsimile to: 571-273-8300.

David B. Bonham
(Printed Name of Person Mailing Correspondence)


(Signature)